

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present Amendment, Claims 8-9 and 22-32 will be all the claims currently pending for the Examiner's consideration.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

I. CLAIM REJECTIONS:

A. 35 USC 112, Second Paragraph & 35 USC 103(a)

Claims 8-9 and 23-32 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite and under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,127,488 or DE 19701487 to Obrecht et al. in view of U.S. Patent No. 5,232,531 to Dammann et al., JP 57-212239 or JP 05-017630.

As the Examiner may recall, the instant case went on appeal at which time Applicants' argued, *inter alia*, that the claimed "non-adhesive" invention was not obvious since one skilled in the art would have expected the combination of references to yield only adhesive compositions unlike the claimed invention.

The Board of Patent Appeals and Interferences issued new grounds for rejection under 35 U.S.C. § 112, second paragraph, for indefiniteness based on the use of "non-adhesive". The Board, however, acknowledged Applicants' arguments that Applicants' particular exemplary embodiments of molded bodies have very little adhesiveness. (Board Decision on Appeal, Pg. 5). Moreover, the Board also appears to accept Applicants' position regarding the non-obviousness nature of the same, but notes that the claims were not commensurate in scope with that argument. Namely, the Board states:

Absent further evidence, we cannot agree with Appellants' contention that the ordinary artisan would be reasonably apprised of the scope of the claims. Independent claims 8 and 9 are not limited to molded bodies (or vulcanate rubber used in the production thereof) of the type specifically identified by Appellants as exhibiting "very little" adhesiveness. Rather, claims 8 and 9 appear to encompass rubber vulcanates and molded rubber bodies having a degree of adhesiveness somewhere between "very great" and "very little." (See Spec. 11:8-10 ("[R]ubber mixtures according to the invention ... are used in the production of molded bodies of any kind.").) Based on the Specification, one of ordinary skill in the art would not recognize the point at which the degree of adhesiveness of a rubber vulcanate or molded rubber body was such that it ceased to fall within the meaning of the claim term "non-adhesive." See *Personalized Media Commc'n's, LLC v. Int'l Trade Comm'n*, 161 F.3d 696,705 (Fed. Cir. 1998) (explaining that a claim is definite if "one skilled in the art would understand the bounds of the claim when read in light of the specification").

(Board Decision on Appeal, Pgs. 5-6)

Per Applicants first response after the Board's decision, Applicants addressed the new grounds for rejection wherein "non-adhesive" was deleted from the claims. In addition, the claims were amended to be directed toward molded rubber bodies selected from the group consisting of cable sheaths, hoses, drive belts, conveyor belts, roller coverings, tire components, shoe soles, gaskets, damping elements and membranes. In light of the above, instantly, the claims are directed toward molded bodies which have, at most, very little adhesiveness.

The cited art when combined, as explained in detail per Applicants' previous responses and Appeal Brief, do not encompass such non-adhesive molded bodies and thus do not render the claimed invention obvious. Moreover, to the extent Examiner is now refusing to give the same patentable weight, Applicants respectfully submit the same is without proper basis as Claim 8 is directed to the utilization of such molded bodies, rather than some mere intended use. And regarding Claim 9, the same is directed to molded bodies *per se* and, therefore, cannot be merely some intended use.

II. CONCLUSION

Applicants submit that the pending claims are in condition for allowance and respectfully request notice to such effect. Should the Examiner have any questions regarding this application, the Examiner is invited to initiate a telephone conference with the undersigned.

The USPTO is hereby authorized to charge any fees which may be required by this paper and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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